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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT RICE and JASON STREIT

Appeal 2009-010919
Application 10/784,708
Technology Center 2400

Before JOSEPH L. DIXON, JOHN A. JEFFERY, and
DEBRA K. STEPHENS, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Patent Examiner rejected claims 1, 2, 4-11, 13-18, and 21-24. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

A. INVENTION

The invention at issue on appeal relates to “electronic document processing and more specifically to a method for collecting, verifying, and notarizing documents through a decentralized system, while satisfying federal and local legal formalities.” (Spec. 1, ll.6-8).

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. A method for verifying a document via a distributed computer network, the method comprising the steps of:

(a) creating an electronic version of the document on a first client in the computer network, wherein said electronic document includes an acceptance option for a Consent to Electronic Records (CER);

(b) storing the electronic document on a server in the computer network;

(c) retrieving the electronic document using a notary application via a second client in the computer network;

(d) presenting a signing party with said acceptance option for said CER;

(e) electronically affixing at least one signing party's signature to the electronic document using said notary application via the second client only if said signing party accepts the CER;

(f) electronically affixing a verifying party's signature and seal to the electronic document using said notary application via the second client, wherein said seal is stored electronically by said notary application, and wherein the verifying party may be any certified party that has authority by law to verify and authenticate the signer of a document; and

(g) storing the signed, notarized, electronic document on said server.

C. REFERENCES

The Examiner relies on the following references as evidence:

Nassiri US 2002/0143711 A1 Oct. 3, 2002

MARTHA A. BRODERICK ET AL., *Electronic Signatures: They're Legal, Now What?*, 11 (5) Internet Research: Networking Applications and Policy, 423-34 (2001), copyright held by MCB University Press, *available at* <http://www.ccs.neu.edu/home/tarase/BrodGibTaraseESig.pdf> (hereinafter "Broderick").

D. REJECTION

Claims 1, 2, 4-11, 13-18, and 21-24 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over Nassiri in view of Broderick. (Ans. 3-8).

PRINCIPLES OF LAW

Only those arguments actually made by the Appellants have been considered in this decision. Arguments which the Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37 (c)(1)(vii) (2008).

"[T]he Board reviews the particular finding(s) contested by an appellant anew in light of all the evidence and argument on that issue." *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential). "Filing a

Board appeal does not, unto itself, entitle an appellant to *de novo* review of all aspects of a rejection. If an appellant fails to present arguments on a particular issue - or, more broadly, on a particular rejection - the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection.” *Id.* (citations omitted).

Burden on Appeal

The allocation of burden requires that the United States Patent and Trademark Office (USPTO) produce the factual basis for any rejection in order to provide an applicant with notice of the reasons why the applicant is not entitled to a patent on the claim scope sought – the so-called “prima facie case.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (the initial burden of proof is on the USPTO “to produce the factual basis for its rejection of an application under sections 102 and 103”) (quoting *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967)). The “prima facie case” serves as a procedural mechanism that shifts the burden of going forward to the applicant, who must produce evidence and/or argument rebutting the case of unpatentability. *See Oetiker*, 977 F.2d at 1445; *Piasecki*, 745 F.2d at 1472.

The Board of Patent Appeals and Interferences’ (Board’s) role on appeal is to, “review adverse decisions of examiners upon applications for patents.” 35 U.S.C. § 6(b). An appellant has the opportunity on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence

of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998), *overruled in part on other grounds*, *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 422 (2007)).

ANALYSIS

Appellants misidentify the grounds of rejection at page 5 of the Appeal Brief as only over the Nassiri publication, and Appellants only present arguments to the reference Nassiri. (Br. 5-10). *Accord* Ans. 2-3 (noting the correct grounds of rejection under § 103 over Nassiri and Broderick in the “Grounds of Rejection to be Reviewed on Appeal” section).

Appellants argue there is no mention of “[c]onsent to [e]lectronic [r]ecords” anywhere in Nassiri, and Appellants do not agree that some type of consent could be reasonably implied in the operation of the Nassiri invention. (Br. 9). Appellants further contend that claims 1, 11, and 18 “do not merely include the use of a CER” (consent to electronic records) but “explicitly recite that the CER function is incorporated into the electronic document itself” and that “[t]his specific implementation is not suggested anywhere in Nassiri.” (Br. 9).

Appellants apparently have misinterpreted the Examiner’s grounds of rejection. The Examiner clearly states that the rejection is over Nassiri in view of Broderick in the final rejection and in the Answer. (Ans. 3, 5, 6, 10). The Examiner relies upon the teachings of Broderick for the CER function and the motivation to modify Nassiri. Since Appellants have not responded to the combination of references, Appellants’ argument necessarily cannot show error in the Examiner’s showing of obviousness of independent claims 1, 11, and 18. Furthermore, Appellants did not respond

to the proper rejection by filing a reply brief. Therefore, we sustain the rejection of representative claim 1.

With respect to the dependent claims, Appellants additionally state “[b]ecause claims 2, 4-10, 13-17, and 21-24 depend from claims 1, 11 and 8 [sic, 18], respectively, they are distinguished from Ballester and Evans for the reasons explained above.” (Br. 10). Since neither of these references has been applied in the any of the office actions in the current prosecution history, Appellants’ summary argument is not a specific argument for patentability. Therefore, claims 2, 4-10, 13-17, and 21-24 fall with their respective independent claims.

CONCLUSION

For the aforementioned reasons, Appellants have not shown error in the Examiner’s showing of obviousness of independent claim 1.

ORDER

We affirm the obviousness rejections of claims 1, 2, 4-11, 13-18, and 21-24.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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